

Remarks

Claims 1-34 are pending in the application. However, the Examiner has only rejected claims 1-32 without addressing the patentability of claims 33 and 34. Applicants believe that all claims, 1-34, are patentable and present arguments below to this effect. Accordingly, reconsideration of the claims is respectfully requested. Furthermore, new claims 35 - 38 have been added and are fully supported by the original application such that they do not constitute new matter.

Anticipation Rejection

Claims 1-32 were rejected under 35 U.S.C. § 102(e) as being unpatentable over *Amos* (U.S. Patent No. 6,554,184). Applicants respectfully assert, however, that this rejection is improper.

The law is clear that a reference must teach every element of a claim, either expressly or inherently, to anticipate the claim. Applicants submit that the Examiner has failed to make a *prima facie* showing of anticipation for at least the reasons presented below.

First, the Examiner has summarily rejected claims 1-32, while only identifying elements in claims 1-5 of the present invention to be allegedly disclosed by *Amos*. Thus, Applicants are left to speculate the factual basis of the Examiner's position with regard to claims 6-32. It is simply impermissible for the Examiner to reject claims absent adequate factual support. Since the Examiner has failed to make a *prima facie* showing of anticipation, the rejection of claims 6-32 is improper.

Similarly, Applicants submit that the Examiner has failed to establish a *prima facie* case of anticipation with regard to claims 1-5. The Examiner's rejection is tenuous at best; it merely recites elements in claims 1-5 verbatim and vaguely concludes that each element is disclosed by *Amos*. However, the Examiner has failed to substantiate his contentions with any sort of specificity beyond directing Applicants' attention to the entire detailed description

to locate support for each element. Essentially, the Examiner generalizes that the *Amos* reference anticipates the claims of the present invention without providing any underlying factual support. Once again, Applicants are required to guess at the factual basis for the Examiner's rejection. Such a requirement is impermissible within the framework of 35 U.S.C. § 102. The precise language of the statute, which provides that "[a] person shall be entitled to a patent unless," clearly places the initial burden on the Patent Office for supplying the factual basis for its rejection. Even if the Examiner doubts the patentability of the invention, the Examiner may not resort to speculation to supply deficiencies in its factual basis. *In re Warner*, 379 F.2d 1011, 1016-1017 (CCPA 1967). Accordingly, Applicants believe that the Examiner's rejection with respect to claims 1-5 is also improper.

Notwithstanding the Examiner's failure to establish a *prima facie* case, Applicants submit that the claims of the present invention are not anticipated by *Amos*. Claim 1 of the present application is directed to a method for performing a money transfer receive transaction and includes the steps of:

- receiving transaction identifying information provided by the recipient;
- comparing the transaction identifying information with transaction data stored on a host computer system;
- providing a confirmation code, to be issued to the recipient, if the transaction identifying information matches the transaction data stored on the host computer system;
- storing the confirmation code on the host computer system;
- receiving at the host computer system input corresponding to the confirmation code from a dispensing terminal in communication with the host computer system;
- comparing the input to the confirmation code stored on the host computer system; and
- allowing funds, corresponding to at least a portion of the desired amount of money, to be dispensed by the dispensing terminal if the input matches the confirmation code stored on the host computer system.

On the other hand, *Amos* is directed to a method and system for providing a hybrid ATM capable of facilitating fund transfers. The device in *Amos* performs a "money

transfer receive transaction” when: (1) a recipient inputs a password, received from an initiator, at the ATM device (Col. 3, lines 1-4); (2) the ATM device verifies the password (Col. 3, lines 4-6); (3) the ATM device sends a message to other hybrid ATM devices, a financial institution and/or a CDBS canceling the pending transaction (Col. 3, lines 6-12); and (4) the ATM device dispenses currency to the recipient (Col. 3, lines 12-13).

Assuming *arguendo* that the password identified in *Amos* constitutes “transaction identifying information provided by the recipient,” *Amos* fails to anticipate other elements of claim 1. For instance, *Amos* fails to teach providing a confirmation code, to be issued to the recipient, if the transaction identifying information matches the transaction data stored on the host computer system; storing the confirmation code on the host computer system; receiving at the host computer system input corresponding to the confirmation code from a dispensing terminal in communication with the host computer; comparing the input to the confirmation code stored on the host computer system; and allowing funds, corresponding to at least a portion of the desired amount of money, to be dispensed by the dispensing terminal if the input matches the confirmation code stored on the host computer system. Rather, *Amos* teaches that a hybrid ATM device dispenses currency to a recipient and clears the money transfer transaction from the system once the password is verified. Accordingly, *Amos* fails to teach each and every element of claim 1 of the present application, and thus, claim 1 and the associated dependent claims are believed to be patentable.


Claim 20 recites steps that are similar to the steps of claim 1. As a result, claim 20 and the associated dependent claims are believed to be allowable for at least the reasons discussed above concerning claim 1.

CONCLUSION

Applicants have made a genuine effort to respond to each of the Examiner's objections and rejections in advancing the prosecution of this case. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If any additional issues need to be resolved, the Examiner is invited to contact the undersigned at his earliest convenience.

Respectfully submitted,

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